



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,711	12/12/2005	Goran Berglund	024445-538	5477
55694 7590 11/03/2008 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209				
EXAMINER				
YEE, DEBORAH				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
11/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,711

Applicant(s)

BERGLUND, GORAN

Examiner

Deborah Yee

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6 to 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6 to 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1 and 6 to 17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claim 1 is objected to because of the following informalities: Process limitation in claim 1 is awkwardly recited. Instead of steel having been "nitriding", it is recommended to use --nitrided--. Also it is recommended that preamble of claim 1 recite --A nitrided stainless steel--. Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 6 to 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 to 11 of U.S. Patent No. 6,475,307 ("Nystrom") in view of US Patent 5,241,748 ("Ishida'748") or US Patent 5,308,089 ("Ishida'089") and further in view of WO 01/79585 ("WO'585").

5. The claims of Nystrom disclose stainless steel alloy for use to make various vehicle and automotive components and having a composition and a martensitic microstructure dispersed with quasi-crystalline particles which meets the pending claims.

6. Even though Nystrom does teach nitriding stainless steel to exhibit a hardened surface layer with a hardness of at least 1200 HV as recited by pending claim 1, such would not be patentable distinction. Note that it is well known and conventional practice to hardened surface of martensitic stainless steel for automotive components to increase wear resistance, durability, and hardness. See Ishida'748 in column 1 and claims 1 and 5 to 10 in columns 5-6 teaches plasma nitriding martensitic stainless steel compression rings for internal combustion engines to increase wear resistance and provide a hardness of greater than HV 700; and Ishida'089 in columns 1-2, lines 5 to 27 in column 4 and claims 2 to 4 in column 8 teaches plasma nitriding martensitic stainless steel cylinders and piston rings for gasoline engines to improve wear resistance and provide a hardness of 900 to 1,300 HV.

7. Even though a hardened surface layer having a thickness of about 0.5 mm as recited by pending claim 9 and a hardness at a surface of the stainless steel is at least twice that of a hardness of at 0.5 mm into a matrix of the stainless steel as recited by

pending claim 8 are not taught by prior art, such would not be a patentable difference since depth and level or hardenability would be a matter of choice and routine optimization well within the skill of the artisan and productive of no new and unexpected results.

8. In addition, Ishida'748 in claims 1 and 5 to 10 teach subjecting martensitic stainless steel to plasma nitriding at a temperature of 500°C which is within the pending claimed temperature range of 450 to 580°C. Even though a time period of 1 to 40 hours in a plasma nitriding atmosphere as recited by pending claim 15 is not taught by prior art, such would be a patentable difference since it would be a matter of choice and routine optimization well within the skill of the artisan to determine time frame depending on the desired level and depth of hardness sought. Also Ishida'748 teaches a hardness level of at least 700HV and Ishida '089 teaches a hardness level of HV 900 to 1300 that would suggest a hardness of at least 1200 HV recited by pending claim 16.

9. Nystrom teaches martensitic stainless steel alloy that meets the pending claimed composition, and in view of Nystrom'307 and/or Nystrom'089, it would be obvious to deposit a wear resistant coating by plasma nitriding to form a hardened nitride surface layer. Moreover, similar to pending claim 14, it would be an obvious modification to deposit an additional wear resistant coating when higher wear resistance is desired, as evident by the English abstract of WO'585.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 and 8 to 13 and 15 to 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,630,103 ("Martin"), Japanese patent 402310339 ("JP-339") or Japanese patent 407011391 ("JP-391") in view of US Patent 5,241,748 ("Ishida'748") or US Patent 5,308,089 ("Ishida'089").
12. Martin in claim 1, the English abstract of JP-391 and the English abstract of JP-339, each teach martensitic stainless steel alloy having a composition with constituents whose wt% ranges overlap those recited by the claims; such overlap in wt% ranges establishes a prima facie case of obviousness because it would be obvious for one skilled in the art to select the claimed alloy wt% ranges over the broader disclosure of the prior art since the prior art teaches similar utility in making industrial components having high hardness, high strength and toughness.
13. More specifically, JP-339 in table 1 on page 212 discloses examples 5, 7-11, 14 and 15 that meet the claimed composition.
14. Also primary prior art teaches making steel alloy in the shape of wire, tube, bar and strip for use as industrial components that would closely meet the structural limitations recited by claims 10 to 13. See lines 55-58 in column 5 of Martin; and paragraphs [0001] and [0020] in English translation of JP-391; and spring equivalent to wire or rod is taught in English abstract of JP-339.
15. Even though primary prior art does not teach nitriding stainless steel to exhibit a hardened surface layer with a hardness of at least 1200 HV as recited by claim 1, such

would be an obvious modification. Note that it is well known and conventional practice to hardened surface of martensitic stainless steel for industrial components to increase wear resistance, durability, and hardness. See Ishida'748 in column 1 and claims 1 and 5 to 10 in columns 5-6 teaches plasma nitriding martensitic stainless steel compression rings for internal combustion engines to increase wear resistance and provide a hardness of greater than HV 700; and Ishida '089 in columns 1-2, lines 5 to 27 in column 4 and claims 2 to 4 in column 8 teaches plasma nitriding martensitic stainless steel cylinders and piston rings for gasoline engines to improve wear resistance and provide a hardness of HV 900 to HV 1,300.

16. Since wear resistance and hardness would be desirable properties sought by primary prior art when using steel for certain industrial application, then it would be an obvious modification well within the skill of the artisan to incorporate the nitriding step to produce no more than the known and expected effect from such additional process step.

17. Even though a hardened surface layer having a thickness of about 0.5 mm as recited by claim 9 and a hardness at a surface of the stainless steel is at least twice that of a hardness of at 0.5 mm into a matrix of the stainless steel as recited by claim 8 are not taught by prior art, such would not be a patentable difference since depth and level or hardenability would be a matter of choice and routine optimization well within the skill of the artisan and productive of no new and unexpected results.

18. In addition, Ishida'748 in claims 1 and 5 to 10 teach subjecting martensitic stainless steel to plasma nitriding at a temperature of 500°C which is within the claimed

temperature range of 450 to 580°C. Even though a time period of 1 to 40 hours in a plasma nitriding atmosphere as recited by claim 15 is not taught by prior art, such would be a patentable difference since it would be a matter of choice and routine optimization well within the skill of the artisan to determine time frame depending on the desired level and depth of hardness sought. Also Ishida'748 teaches a hardness level of at least 700HV and Ishida '089 teaches a hardness level of Hv 900 to 1300 that would suggest a hardness of at least 1200 HV recited by claim 16.

19. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,630,103 ("Martin"), Japanese patent 02-310339 ("JP-339") or Japanese patent 407011391("JP-391") in view of US Patent 5,241,748 ("Ishida'748") or US Patent 5,308,089 ("Ishida'089") as applied to claims 1, 8 to 13 and 15 to 17 above, and further in view of WO 01/79585 ("WO'585").

20. Primary prior art teaches martensitic stainless steel alloy that meets or closely meet the claimed composition; and in view of Ishida'089 and/or "Ishida'748", it would be obvious to deposit a wear resistant coating by plasma nitriding to form a hardened nitride surface layer. Moreover, it would be an obvious modification to deposit an additional wear resistant coating when higher wear resistance is desired, as evident by the English abstract of WO-585.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on monday-friday 6:00 am-2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah Yee/
Primary Examiner, Art Unit 1793

/DY/